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OFFICE OF PETITIONS

In re Application of
Schwalke, et al.
Application No. 09/462,994
Filed: January 14, 2000
Attorney Docket No. P99.2666

DECISION ON PETITION

This is a decision on the "Petition to Consider Correspondence Filed in the United States Patent and Trademark Office under 37 CFR 1.10," filed February 20, 2002 (certificate of mailing February 1, 2002)¹.

Application papers were received in the above-identified application on January 14, 2000. In their response to the non-final Office action mailed July 13, 2001, applicants *inter alia* directed the examiner's attention to a Preliminary Amendment filed with the application. In turn, the examiner in his final Office action mailed January 2, 2002, informed applicants *inter alia* that the referenced Preliminary Amendment was not of record in the application. Furthermore, the examiner advised applicants, that if they had evidence of the prior filing of a Preliminary Amendment, to file a petition and submit the evidence so that the application can be reconsidered by the Office based on the newly provided evidence.

Accordingly, applicants filed the instant petition requesting that 1) the preliminary amendment submitted with the petition be considered as filed in the Office on the USPS deposit date of January 14, 2000; and 2) the examiner remove the finality of the

¹ 37 CFR 1.10(e) applies only in those situations in which the correspondence at issue was lost *in toto* (i.e., the entire correspondence was not delivered to the Office). Where there is a dispute as to the contents of correspondence submitted to the Office (e.g., an applicant asserts that three sheets of drawings were submitted under 37 CFR 1.10 with an application, but the Office records indicate receipt of only two sheets of drawings with the application), an applicant may not rely upon the provisions of 37 CFR 1.10(e) to establish what document(s) and/or fee(s) were filed in the Office with such correspondence. Rather, where the records of the Office (e.g., the file of the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP §503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office.

last Office action dated January 2, 2002 and provide an Office action that incorporates the preliminary amendment lost by the Office. In support thereof, applicants submitted *inter alia* a copy of their postcard receipt identifying this application by serial number, itemizing "Preliminary Amendment" among the enclosures, bearing a PCT/PTO receipt date-stamp of January 14, 2000, and lacking any notation of non-receipt of any item listed; and a copy of their form PCT/DO/EO/903 acknowledging receipt by the Office of a Preliminary Amendment filed "14 January 2000" in the subject application.

Preliminarily, it is concluded that the instant petition was filed promptly after applicants became aware by Office action mailed January 2, 2002 of the non-receipt of the Preliminary Amendment. Furthermore, petitioner's arguments and evidence have been considered, and found persuasive that the application as filed on January 14, 2000 included a Preliminary Amendment. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the Office of all items listed thereon on the date stamped thereon by the Office. See MPEP 503. The postcard submitted identifies the preliminary amendment, but its persuasive weight is diminished to the extent that the number of pages of the Preliminary Amendment are not specifically noted. Nonetheless, this evidence is considered in light of the form PCT 903 submitted. This form acknowledges that a Preliminary Amendment filed on "14 January 2000" is a part of the application.

In view thereof, the petition is GRANTED.

Given the basis for granting the petition, no petition fee is due and none has been charged.

Applicants have shown that the Preliminary Amendment filed January 14, 2000 should have been present in the application for consideration by the Examiner.

Accordingly, the application file is being returned to Technology Center 2823 for action in accordance with this decision.

Telephone inquiries concerning this decision should be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.

A handwritten signature in cursive script, reading "Patricia Faison-Ball". Below the signature, the word "for" is written in a smaller, simpler script.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy